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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,189	01/18/2001	Motoharu Kasuya	2001-0035A	5986

513 7590 01/15/2003

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EXAMINER

MAI, TRI M

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/761,189

Applicant(s)

KASUYA, MOTOHARU

Examiner

Tri M. Mai

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-10 and 14-19 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 7, 9, 10 and 14-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14. 6) ☐ Other: .

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## DETAILED ACTION

### *Election/Restrictions*

1. Claims 7 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention as set forth in the previous Office Action.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, one of the ends of the container being formed by inwardly curling its edge with a circumferential edge of a paper material in claim 10, the tangent line, and the radial distance in claims 15 and 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 6, 9-10, and 14-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6502741. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to eliminate the protective material covering when it is not needed.

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 6, 9-10, and 16-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure does not support the curled portion being greater than 0 and less than 180 degrees. Furthermore, the original disclosure does not support one of the ends of the container being formed by inwardly curling its edge with a circumferential edge of a paper in claim 10. Furthermore, the original disclosure does not support the relationship as set forth in claims 14-19. This is a new matter rejection.

7. Claims 9, 10, and 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, "detactably" is misspelled.

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In claim 10, the claim recites a pressed curled portion at each of the two ends. The claim goes on to recite "said pressed curled portion". It seems that "portion" should be --portions-- for consistency.

Claims 14-19 are confusing. It is unclear what are the tangent line, the line on the surface, and the radial distance. It is unclear how a line that is tangent to the surface of the curled portion is parallel to the axis of the roll. It seems that this relationship is impossible. With respect on the line on the surface, the cylindrical surface itself is parallel to the surface, not by a line defined by the surface. Furthermore, it is unclear exactly what is this radial distance is.

***Claim Rejections - 35 USC § 102/103***

8. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Done (GB 2314827). Done teaches a paper container having an axis, an outer straight cylindrical body, and an inward curled portion as shown in fig. 3. Please note that the curled portion is denser due to the action of the former 16.

9. Claims 9, 10, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Done in view of Beadle (1031615), and further in view of Beran et al. (UK 492163). Done meets all claimed limitations except for the closure and a bottom closure. Beadle teaches that it is known in the art to provide a detachable cover 4. It would have been obvious to one of ordinary skill in the art to provide a detachable cover in Done as taught by Beadle to open the container easily.

With respect to the bottom closure, Done teaches that it is known in the art to provide a paper bottom closure. It would have been obvious to one of ordinary skill in the art to provide a bottom closure in Done as taught by Beran et al. to secure the content.

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Please note that Done further teaches the curling of the container while the adhesive is soften (page 2, lines 10-13, 50-53).

Regarding claim 16-19, it would have been obvious to one of ordinary skill in the art to provide such dimension to provide the desired angle and/or size of the curl.

10. Claims 6, 9, 10, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Done rejections as set forth in paragraphs 3 or 4, and further in view of either Perkins (149516) or Wright (1096880). To the degree it is argued the curls in done is not the pressed curl as claimed. Perkins teaches that it is known in the art to provide an angle curl. Furthermore, it is noted that Wright teaches that it is known in the art to provide a pressed inward curl for a paper receptacle. It would have been obvious to one of ordinary skill in the art to provide an angled curl in done as taught by either Perkins or Wright to provide added stability and/or to accommodate a closure more easily.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

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Tri M. Mai  
Examiner  
Art Unit 3727



January 10, 2003